

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 59-109 are pending in the application, with 59, 78, and 93 being the independent claims. Claims 1-58 were previously cancelled. Claims 59, 78, and 93 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under Double Patenting

In paragraphs 9-11 of the Office Action, the Examiner rejected claims 59-78 and 93-109 under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of U.S. Patent No. 6,654,800 to Charles J. Rieger III. Without acquiescing to the propriety of the rejection, Applicants submit herewith a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome this rejection.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims. Furthermore, Applicants respectfully request that the objection to dependent claims 79-92, due to the "deficiencies of their respective parent claim," be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

In paragraph 4 of page 3 of the Office Action, claims 59-109 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,842,810 to Sotiroff *et al.* (hereinafter Sotiroff), in view of U.S. Patent No. 5,898,680 to Johnstone *et al.* (hereinafter Johnstone) and further in view of U.S. Patent No. 5,990,886 to Serdy *et al.* (hereinafter Serdy). Applicants respectfully traverse the rejection, and request that it be withdrawn.

Applicants assert that a prima facie case of obviousness has not been established in the Office Action for at least the reason that the cited art does not teach or suggest each and every element of independent claim 59, as amended.

Furthermore, Applicants assert that a prima facie case of obviousness has not been established in the Office Action for at least the reason that a motivation to combine the cited art is not present.

Sotiroff appears to allow users to search for housing, by selecting a point of interest on a map. For example, see FIG. 4, which shows a quadrant map. A user selects a point of interest 34 on the quadrant map. For a property at the selected point of interest 34 on the map, further information is provided to the user. For example, FIG. 5 shows a picture and text related to the property.

In Johnstone, a satellite based digital broadcast system is used to provide digital maps to users at remote locations. For example, see FIG. 1. Users have terminals 22 equipped with Global Positioning System (GPS) receivers which allow a user's location to be determined. A general map, such as shown in FIG. 12A, is downloaded to the

user's receiver terminal 22, which is converted to a location specific map, such as shown in FIG. 12B, by the processor of terminal 22.

Serdy appears to allow a user to create a list of e-mail address (i.e., for the destination of an email) at least in part by selecting a region of a map. For example, see FIG. 1, which shows a map 121. Map 121 has buildings, etc, represented as blocks 124, that have email addresses associated with them. The e-mail distribution list is created by selecting a subset of the potential recipients on the map 121, by positioning a graphical area selector 134 over map 121, as shown in FIG. 6.

Sotiroff, Johnstone, and Serdy do not teach each and every element of claim 59. For example, claim 59 recites, in part:

- (d) processing a subsequent request from the user, the subsequent request including a user identification tag and an antenna descriptor specifying a subsequent geographical location of the user, said processing a subsequent request from the user including:
 - (1) sending to the user other postings having geographical regions that contain the subsequent geographical location, wherein the other postings do not include any posting previously sent to the user.

Sotiroff does not teach sending to the user other postings having geographical regions that contain the subsequent geographical location, wherein the other postings do not include any posting previously sent to the user, as recited in claim 59. There is no indication in Sotiroff that subsequently sent postings do not include any postings previously sent to the user. In fact, it appears that in Sotiroff, each time a point of interest is selected on the map, the same information will be provided to a user.

Johnstone nor Serdy do not even disclose postings as recited in claim 59. Thus, neither of Johnstone and Serdy teach or suggest sending to the user other postings having

geographical regions that contain the subsequent geographical location, wherein the other postings do not include any posting previously sent to the user, as recited in claim 59.

Thus, for at least this reason, claim 59 is patentable over Sotiroff, Johnstone, and Serdy.

Furthermore, a motivation to combine Sotiroff, Johnstone, and Serdy in the manner described in the Office Action is not present. Sotiroff does not teach or suggest each request from a user including a user identification tag and an antenna descriptor, the antenna descriptor identifying a geographical location of the user, as recited in claim 59. In Sotiroff, a user selects properties from a map with a pointing device (see Abstract). Thus, Sotiroff does not disclose, or even relate to location information of the user. On page 6, the Office Action appears to allege that Johnstone can be combined with Sotiroff to add "each request from a user including a user identification tag and an antenna descriptor, the antenna descriptor identifying a geographical location" of the user. However, such modification would render Sotiroff unsatisfactory for its intended purpose - supporting users who select properties from a map with a pointing device - which is contrary to established case law. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01, quoting *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Instead, Sotiroff is directed to users that search for housing on a map with a pointing device. Modifying Sotiroff in this manner diverts Sotiroff from its intended purpose, as Sotiroff has no need for user location information from Johnstone.

In fact, such a modification to Sotiroff would be undesirable, because, assuming *arguendo* that Sotiroff and Johnstone are combined, a user attempting to search housing in a geographic region (according to the combination) would be limited to searching housing located at their current position. In contrast, Sotiroff alone allows a user to search anywhere on a map using a pointing device. Searching with a pointing device on a graphical map (according to Sotiroff) is much easier than a user having to travel from geographical location to geographical location to search housing. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). As described above, the references do not suggest the desirability of the combination, and in fact the combination would be inferior to Sotiroff alone.

Serdy does not overcome the deficiencies of Sotiroff and Johnstone with respect to this combination. Thus, a motivation to combine Sotiroff, Johnstone, and Serdy, as indicated in the Office Action, is not present. Thus, for at least this reason, claim 59 is patentable over Sotiroff, Johnstone, and Serdy.

As described above, Applicants assert that independent claim 59 is patentable over Sotiroff, Johnstone, and Serdy, alone or in combination, for at least the reasons stated above. Independent claims 78 and 93 are also patentable over Sotiroff, Johnstone, and Serdy, alone or in combination, for at least the reasons provided above for claim 59. Applicants assert that claims 60-77, which depend from claim 59, claims 79-92, which depend from claim 78, and claims 94-109, which depend from claim 93, are also patentable over Sotiroff, Johnstone, and Serdy, alone or in combination, for at least the

reasons described above with regard to their respective independent claims, and further in view of their own features. Accordingly, Applicants respectfully request that the rejection of these claims be reconsidered and withdrawn.

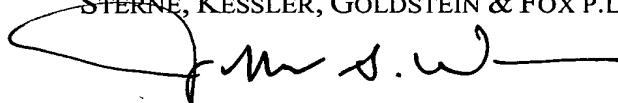
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read 'J. M. S. W.', is written over a horizontal line.

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